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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,058	12/11/2003	Hikaru Kobayashi	075834.00460	7840
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ROBERT J. DEPKE LEWIS T. STEADMAN ROCKEY, DEPKE & LYONS, LLC SUITE 5450 SEARS TOWER CHICAGO, IL 60606-6306			EXAMINER MARINI, MATTHEW G	
			ART UNIT 2854	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,058

Applicant(s)

KOBAYASHI ET AL.

Examiner

MATTHEW G. MARINI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/315542.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The action of 12/04/2007 is hereby vacated, and is replaced by the following action, which is in response to applicant's pre-brief conference request filed 2/06/2008.

Election/Restrictions

Newly submitted claims 17-24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 17 and 21 do not require the structure of the adhesive labels being in the form of a roll as seen in independent claims 6, 7 and 11, and therefor are restricted based on original presentation, due to the fact that the medium could be in the form of sheets requiring a completely different and separate apparatus to perform the method steps. Also, claims 17 and 21 require an uncut medium comprising several different layers, where the medium is cut by a cutting step. However, independent claims 6, 7, and 11 recited a medium which has already been cut, not actually reciting any cutting means. Therefore, claims 17 and 21 are also restrictable based on the fact that claims 17 and 21 require cutting means to perform the cutting steps, therefore requiring a completely separate and different apparatus as to what is being claimed in the independent claims 6, 7, and 11.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-24 have been withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "printing layer that has been only partially cut" is not supported by the original specification or drawings since applicant has only described or shown partially cutting the entire printing medium by cutting through the entire printing layer. To further prosecution, the examiner has interpreted these claims according to the specification and Fig. 5a, where it discloses the printing medium only being partially cut by fully cutting the printing layer, 9b, and leaving the release layer uncut, 9a. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Avery (2,391,539).

As to Claim 6, Avery teaches in Fig. 1 a roll-shaped printing medium, 10 and 15, Col. 2 lines 31-37, comprising; a printing surface, the top surface of 10, on which one or more images are capable of being printed; a printing layer, 10, that is releasable adhered via adhesive, 22, to a release layer, 15, the release layer, 15, for holding said printing layer, top surface of 10, wherein a first longitudinal portion, 26, of said printing medium, 10 and 15, has said printing layer, top surface of 10, that has been at least cut along a conveying direction of the printing medium at an interval capable of corresponding to the dimension (size) of the images yet to be printed in a width direction, and wherein said roll has a second portion, 27, wherein the printing layer, the top surface of 10, is not cut along a conveying direction of the printing medium, 10 and 15, and wherein neither the first portion, 26, nor the second portion, 27, contain width-wise cuts in a direction perpendicular to the conveying direction of the printing medium, 10 and 15, as seen in Fig. 2.

As to Claim 7, Avery teaches in Fig. 1 a roll-shaped printing medium, 10 and 15, capable of being used in a roll printer comprising: a printing surface, the top surface of 10, on which one or more images are capable of being printed; a printing layer, 10, that is releasable adhered via adhesive, 22, to a release layer, 15, the release layer, 15, for holding said printing layer, top surface of 10; wherein the layers, 10 and 15, comprising

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the medium are capable of being rolled in a spiral shape to form a roll-shaped printing medium, similar to Col. 2 lines 31-37, wherein a first longitudinal portion, 26, of said printing medium, 10 and 15, has said printing layer, top surface of 10, that has been at least cut along a conveying direction of the printing medium at an interval capable of corresponding to the dimension (size) of the images yet to be printed in a width direction, and wherein said roll has a second portion, 27, wherein the printing layer, the top surface of 10, is not cut along a conveying direction of the printing medium, 10 and 15, and wherein neither the first portion, 26, nor the second portion, 27, contain width-wise cuts in a direction perpendicular to the conveying direction of the printing medium, 10 and 15, as seen in Fig. 2.

As to Claims 8 and 12, Avery teaches in Fig. 1 a roll-shaped printing medium, 10 and 15, capable of being used in a roll printer wherein said image forming portion, top surface of 10, extends substantially the entire longitudinal length of said print medium, 10 and 15.

As to Claim 9 Avery teaches in Fig. 1 a roll-shaped printing medium, 10 and 15, capable of being used in a roll printer wherein there are at least three cuts, 26, made in the longitudinal direction of said printing layer, top surface of 10, as seen in Fig. 1, and wherein each cut, 26, is spaced apart at a pre-determined distance in a direction perpendicular to the conveying direction of the print medium, 10 and 15.

As to Claim 10, Avery teaches in Fig. 1 a roll-shaped printing medium, 10 and 15, capable of being used in a roll printer wherein there are at least three cuts, 26, made in the longitudinal direction of said printing layer, top surface of 10, as seen in Fig. 1, and

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wherein each cut, 26, is spaced apart at a pre-determined distance in a direction perpendicular to the conveying direction of the print medium, 10 and 15.

As to Claim 11, Avery teaches in Fig. 1 a printing medium, 10 and 15, capable of being used in a printer comprising: a printing surface, the top surface of 10, on which one or more images are capable of being printed; a printing layer, 10, that is releasable adhered via adhesive, 22, to a release layer, 15, the release layer, 15, for holding said printing layer, top surface of 10, wherein a first longitudinal portion, 26, of said printing medium, 10 and 15, has said printing layer, top surface of 10, that has been at least cut along a conveying direction of the printing medium at an interval capable of corresponding to the dimension (size) of the images yet to be printed in a width direction, and wherein said roll has a second portion, 27, wherein the printing layer, the top surface of 10, is not cut along a conveying direction of the printing medium, 10 and 15, and wherein neither the first portion, 26, nor the second portion, 27, contain width-wise cuts in a direction perpendicular to the conveying direction of the printing medium, 10 and 15, as seen in Fig. 2.

As to Claim 13, Avery teaches in Fig. 1 printing medium, 10 and 15, capable of being used in a printer wherein there are at least three cuts, 26, made in the longitudinal direction of said printing layer, top surface of 10, as seen in Fig. 1, and wherein each cut, 26, is spaced apart at a pre-determined distance in a direction perpendicular to the conveying direction of the print medium, 10 and 15.

As to claims 14-16, Avery teaches in Fig. 1 printing medium, 10 and 15, wherein said image-forming portion, top surface of 10, of said printing medium, 10 and 15, has

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said printing layer, 10, that has been cut via cutting device, 24, along a conveying direction of the image printing medium, 10 and 15, leaving the release layer, 15, uncut.

Response to Arguments

Applicant's arguments with respect to claims 6-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew G. Marini whose telephone number is (571)-272-2676. The examiner can normally be reached on Monday-Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571)-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Marini
5/21/08

/Leslie J. Evanisko/
Primary Examiner, Art Unit 2854